

Appln No. 09/609,303
Amdt. Dated July 14, 2004
Response to Office action of March 16, 2004

13

REMARKS/ARGUMENTS

The Office Action has been carefully considered. The issues raised are traversed and addressed below with reference to the relevant headings and paragraph numbers appearing under the Detailed Action of the Office Action.

Specification

Pages 1 and 2 of the specification have been amended to update the list of co-pending applications with USPTO application serial numbers.

In view of the Examiner's objections raised in paragraph 2 of the Office Action, the use of the Trade Mark "memjet" has been amended to capitalise the Trade Mark and introduce reference to generic terminology. We believe that this overcomes the objections raised against the specification.

Claim Objections

In view of the claim objections raised in paragraph 3 of the Office Action, claim 13 and claims 8 and 27 have been revised as requested by the Examiner and we believe that this overcomes the Examiner's objections.

Claim Rejections – 35USC § 112

In view of the objections raised in paragraph 4 of the Office Action, the term "substantially invisible" has been revised to refer to "invisible", which we believe overcomes the Examiner's objections. A basis for this amendment can be found on page 12, line 9, and at a significant number of other places in the specification, such as page 15, line 26.

Claim Rejections – 35USC § 102

In this section, the Examiner has objected to claims 1 to 34 as being anticipated by Wolff et al. We respectfully submit that Wolff is not relevant to the patentability of the present claims.

Wolff et al disclose a system which provides for manual entry interactive paper and electronic document handling processing. However, there is no disclosure in Wolff et al of the use of such papers to enable registration of a user to allow the user to use a computer system, as required by the current claims.

In particular, the independent claims specifically required the use of a printed registration form containing information relating to user registration and including coded data indicative of the identity of the form. Whilst a type of form processing is described in general terms (for example in column 2 lines 52 onwards) in Wolff et al, there is no description of any type of registration procedure. Only a limited number of examples of use of the interactive paper are described and none of these encompass registration.

In view of this, we respectfully submit that the document Wolff et al does not teach or suggest providing a printed registration form and identifying, in the processing system and from the indicating data, at least one parameter relating to user registration, as required by claim 1. For this reason alone we submit that all of the claims are novel and inventive over the cited prior art.

Appln No. 09/609,303
Amdt. Dated July 14, 2004
Response to Office action of March 16, 2004

14

We note that the Examiner has specifically referred to column 9, line 64 through column 10, line 9 of Wolff. Whilst this section highlights that other applications and variations are permissible, there is no suggestion, let alone meaningful disclosure, of Wolff et al contemplating user registration. This section does not therefore anticipate a claim directed towards user registration which specifically requires the identification of at least one parameter relating to user registration.

In the event that the Examiner is minded to reject our arguments with respect to the independent claims, we believe the dependent claims include features which are clearly not encompassed by Wolff et al. For example, claim 3 relates to the indicating data including time varying position information regarding movement of the sensing device. Whilst the Examiner has correctly identified that Wolff et al does describe generating movement data indicative of movement of the device it is important to take into account that claim 3 requires that the indicating data is generated using coded data on the form.

Thus, in claim 3, as it depends on claim 1 (via claim 2) the requirement is that the time varying position information is generated using the coded data. We respectfully submit that this is not shown by Wolff et al.

In the system disclosed by Wolff et al, an initial position of the sensing device is defined upon scanning a barcode. The system then determines relative movement of the sensing device from the initial location using gyroscopic rate information as set out in column 4 lines 52 onwards.

Thus, we respectfully submit that in the system of Wolff et al it is not possible to generate movement data from the sensing of coded data. Movement data is determined solely on the basis of gyroscopic rate information, or through the use of an infrared detector which triangulates the position of the sensing device using scanning beams generated by an IR tracking system, as described in column 7, line 30 onwards.

Thus, the system of Wolff et al does not generate time varying position information (ie movement data) using the sensed coded data. Instead, the system of Wolff et al generates an initial position indication using the scanned coded data. This position information is transferred to the computer system, with the pen then generating movement data based on gyroscopic rate information, or the infrared tracking system. This allows the computer to determine the current position of the pen. We respectfully submit therefore that claim 3 provides further distinctions over the prior art.

To further clarify this distinction new claims 35 to 38 have been added which specifically refer to the indicating data being generated using sensed coded data. In addition to finding a basis for this in the original claim 3, a basis can also be found for example on page 30, line 5 onwards of the specification.

In addition to this, we respectfully submit that other ones of the dependent claims provide further distinctions over Wolff et al. In particular, claim 6 relates to the at least one text parameter comprising registration data identifying said user and claim 7 further specifies that this includes identification and content details associated with said user.

The Examiner has also asserted that claims 11, 23, 29 and 34 do not add anything inventive to the teaching of Wolff et al. We respectfully submit that this is not the case. In particular, in Wolff et al it is necessary for the user to scan a barcode to thereby identify the documents under consideration and the position of the sensing device in the document. In order for the user to be able to do this it is essential that the barcode be provided in visible ink, and there is certainly no suggestion, let alone disclosure, of an alternative system. In contrast to this, the present

Appln No. 09/609,303
Amdt. Dated July 14, 2004
Response to Office action of March 16, 2004

15

invention utilises a system whereby coded data can be provided substantially over an entire page. The coded data is provided coincidently with information relating to user registration which indicates to the user where interaction of the document is required. Providing invisible coded data allows the coded data to be coincident with the information without affecting the user's ability to discern the information. This in turn allows movement of the sensing device with respect to the interface surface to be determined. The features enabling this capability are not taught or suggested by Wolff et al, which requires the use of a completely alternative sensing means as coded data cannot be provided coincidently with information.

In view of the above comments we respectfully submit that the independent claims are novel and inventive over Wolff et al. In the event that the Examiner is minded to maintain rejections against these claims we would also highlight that novel and inventive features are imparted by the independent claims.

In light of the above, it is respectfully submitted that the objections and claim rejections have been successfully traversed and addressed. The amendments do not involve adding any information that was not already disclosed in the specification, and therefore no new matter is added. Accordingly, it is respectfully submitted that the claims 1 to 38, and the application as a whole with these claims, are allowable, and a favourable reconsideration is therefore earnestly solicited.

Very respectfully,

Applicants:



PAUL LAPSTUN

KIA SILVERBROOK

C/o: Silverbrook Research Pty Ltd
393 Darling Street
Balmain NSW 2041, Australia

Email: kia.silverbrook@silverbrookresearch.com

Telephone: +612 9818 6633

Facsimile: +61 2 9555 7762